REMARKS

Reconsideration of the above identified patent application is respectfully requested in view of the foregoing amendments and following remarks. Claims 1-20 were originally filed. Claims 1-11 have been withdrawn. Claims 12 and 19 have been amended and Claims 21-22 were added. By this amendment, Claims 16, 18, 19, and 21 have been amended. Therefore, Claims 12-22 are pending in the present application.

The Examiner rejected Claims 12-22 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite "in reciting 'a [mouthfeel] test' (claim 1, line 3) since this term is relative without any clear meaning in the art and it is not known which test is intended.

The Examiner rejected Claim 16 as being allegedly indefinite in reciting "may consist of", which should be changed to "is selected from". Accordingly, Applicant has amended Claim 16.

The Examiner rejected Claim 19 as being allegedly indefinite in reciting "my comprise of', which should be changed to "is selected from". The Examiner stated the "a" in claim 19 should be changed to "the". Accordingly, Applicant has amended Claim 19, using Markush claim construction language, and changed the "a" to "the".

The Examiner rejected Claim 18, stating there is no antecedent basis in claim 12 for "the container" (claim 18), which can be corrected by changing "container" to "receptacle". Accordingly, Applicant has amended Claim 18, changing "container" to "receptacle".

The Examiner rejected Claim 21, stating Claim 21 is indefinite in reciting "has an appearance" since it is not understood how a mouthfeel test can affect appearance. Corrections are required without new matter.

The Examiner rejected Claims 12-22 under 35 U.S.C. §103(a) as being allegedly unpatentable over each of the following articles cited by applicant: Mai Mai Sweet Potato Pie, Sweet Potato Pie No. 2750, Mai Mai Sweet Potato Pie No. 2298, Sweet Potato Pie by Ceideburg or Sweet Potato Pie (From My Garden).

The Examiner rejected Claims 12-15 and 17-22 are also rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over No-Crust Sweet Potato Pie.

Applicant respectfully traverses the Examiner's rejections of claims 12-22 under 35 U.S.C. §112, second paragraph, and 35 U.S.C. §103(a) in the following discussion.

35 U.S.C. §112, second paragraph

The Examiner rejected Claims 12-22 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite "in reciting 'a [mouthfeel] test' (claim 1, line 3) since this term is relative without any clear meaning in the art and it is not known which test is intended. Applicant respectfully traverses the Examiner's rejection based on Applicant's specification, page 8, lines 20-22, page 9, the whole page, and page 10, lines 1-12, that defines the mouthfeel test as follows:

> "Typically, expert taste testers are able to determine in food products and dessert fillings if the texture attribute of smoothness is acceptable through a test known in the food industry as the 'mouthfeel test'. Food companies may utilize professional taste testers who have tasted sweet potato compositions, wherein the taste testers are able to distinguish the sweet potato composition mouthfeel through the mouthfeel test.
>
> Another methodology for determining the mouthfeel of a sweet potato composition is through consumer taste tests. Consumers are given samples of a sweet potato composition and are asked to comment on the mouthfeel of said

sweet potato composition. A consumer survey of a sweet potato composition's mouthfeel often gives results that are consistent with those given by professional taste testers."

A consumer survey was conducted on the sweet potato composition 70 where said consumers were asked to taste said sweet potato composition 70. The samples of sweet potato composition 70 were presented to the consumers and a ballot completed judging four categories. The categories judged were: Color, Texture, Flavor, and Overall on a scale from 1-9, as defined in Table 1:

Table 1

9 = like extremely
8 = like very much
7 = like moderately
6 = like slightly
5 = neither like or dislike
4 = dislike slightly
3 = dislike moderately
2 = dislike very much
1 = dislike extremely

The average of the results are listed in Table 2. It has been found that an effective concentration of mouthfeel enhancers; the transformation of said mouthfeel enhancers; and the activation of other chemicals inherent to sweet potatoes is critical to achieving an acceptable mouthfeel.

Table 2

Sample	Appearance	Texture	Taste	Overall
1	8.5	8.4	8.2	8.3
2	5.8	5.1	5.4	5.8

Applicant respectfully submits the Examiner has not supported his rejection that Claims 12-22 under 35 U.S.C. §112, second paragraph are allegedly indefinite "in reciting 'a

[mouthfeel] test' (claim 1, line 3). Applicant respectfully submits that "mouthfeel test" is not relative and not without any clear meaning in the art and it is known which test is intended. See the Office Action, page 2, paragraph 3, lines 3-5.

Applicant's specification supports that the mouthfeel test is not relative, has clear meaning in the art and it is known that the mouthfeel test is intended because it is used by expert taste testers in the food industry. See Applicant's specification, page 8, lines 20-22 and page 9, line 1 (stating "Typically, expert taste testers are able to determine in food products and dessert fillings if the texture attribute of smoothness is acceptable through a test known in the food industry as the 'mouthfeel test'. Food companies may utilize professional taste testers who have tasted sweet potato compositions, wherein the taste testers are able to distinguish the sweet potato composition mouthfeel through the mouthfeel test."). Applicant discloses that the mouthfeel test is not relative because consumer taste tests may be used to determine the mouthfeel of a sweet potato composition.

Applicant's specification supports that the mouthfeel test is not relative, has clear meaning in the art and it is known that the mouthfeel test is intended because Applicant discloses a consumer survey was conducted on the sweet potato composition. See Applicant's specification, page 9, lines 10-25 and page 10, line 1-12 (stating "A consumer survey was conducted on the sweet potato composition **70** where said consumers were asked to taste said sweet potato composition **70**. . . . The categories judged were: Color, Texture, Flavor, and Overall on a scale from 1-9, as defined in Table 1: . . . The average of the results are listed in Table 2.")

The Examiner rejected Claim 21, stating Claim 21 is indefinite in reciting "has an appearance" since it is not understood how a mouthfeel test can affect appearance. Corrections are required without new matter. See the Office Action, page 2, paragraph 3, line 9 to page 3, lines 1-2. Applicant respectfully traverses the Examiner's rejection because Claim 21 claims, "and wherein appearance refers to lack of sweet potato strings present in the sweet potato composition." Therefore, the edible composition has an appearance in a range from about 5.2 to about 9.0, based on a mouthfeel test, because of "lack of sweet potato strings present in the sweet potato composition". Claim 21, clarifying how appearance, i.e. potato strings in the sweet potato composition, can affect the mouthfeel test is not new matter because Applicant's specification supports Claim 21, disclosing:

> "The standard deviation for appearance, **wherein appearance refers to lack of sweet potato strings present in the sweet potato composition 70**, give three ranges where the mean value of 8.5 may lie. One standard deviation gives a range from about 7.4 to about 9.0; two standard deviations give a range from about 6.3 to about 9.0; and three standard deviations give a range from about 5.2 to about 9.0." A range from about 5.2 to about 9.0 is a preferred range for the **appearance** of the sweet potato composition **70**; with from about 6.3 to about 9.0 the more preferred range; and from about 7.4 to about 9.0 the most preferred range for **said appearance** of said sweet potato composition **70**. The Specification, page 10, lines 22-24, to page 11, lines 1-5.

In light of the foregoing discussion, Applicant respectfully contends the Examiner's rejection of Claims 12-22 as being allegedly indefinite under 35 U.S.C. §112, second paragraph fails because the "mouthfeel test" is not relative and not without any clear meaning in the art and it is known which test is intended. Secondly Applicant respectfully contends the Examiner's rejection of Claim 21 as being allegedly indefinite under 35 U.S.C. §112, second paragraph in reciting "has an appearance" since it is not

understood how a mouthfeel test can affect appearance fails because the edible composition has an appearance in a range from about 5.2 to about 9.0, based on a mouthfeel test, because of "lack of sweet potato strings present in the sweet potato composition".

35 U.S.C. §103(a)

The Examiner rejected Claims 12-22 under 35 U.S.C. §103(a) as being allegedly unpatentable over each of the following articles cited by applicant: Mai Mai Sweet Potato Pie, Sweet Potato Pie No. 2750, Mai Mai Sweet Potato Pie No. 2298, Sweet Potato Pie by Ceideburg or Sweet Potato Pie (From My Garden). The Examiner states "the mouthfeel, appearance and taste of each sweet potato pie in the articles is obviously well liked by some consumers and would have a number within applicant's claimed range or else the recipe would not have been published." The Office Action, page 3, paragraph 5, lines 8-11. Applicant respectfully traverses the Examiner's rejection of Claims 12-22 over each of the articles cited by the Examiner because the articles do not teach or suggest each and every feature of Applicant's Claims 12-22. Specifically the Examiner's conclusion, *inter alia*, is not taught or suggested by the prior art cited by the Examiner. Nowhere does the Examiner's prior art teach or suggest, *inter alia*, that "well liked by consumers corresponds to a [mouthfeel] rating within applicant's claimed range, as in Applicant's Claims 12-22. Therefore, the Examiner has not met his burden for making a prima facie case of obviousness, so the Examiner should withdraw his rejection of claims 12-22.

The Examiner states "Further, new recipes or formulas which involve addition or elimination of common ingredients, or **for treating them in ways which differ from former**

practice, do not amount to invention merely because it is not disclosed that no one else ever did what applicant did. Applicant must establish coaction or cooperative relationship between ingredients which produces a new, unexpected and useful function. (In re Levin, 84 USPQ 232)." Id. The Examiner's rejection fails because in fact Claims 12-22 claim and the Specification supports a method of making an edible sweet potato composition that has a taste, appearance, and texture, said taste, appearance, and texture, being based on a mouthfeel in a range based on a mouthfeel test, wherein the test has a range from 1-9, wherein a 1 means dislike extremely and a 9 means like extremely, as in Applicant's Claims 12-22. Therefore, the Examiner's requirement that "Applicant must establish coaction or cooperative relationship between ingredients which produces a new, unexpected and useful function," is satisfied because the method disclosed in Claims 12-22 and supported by the Specification does "establish coaction or cooperative relationship between ingredients which produces a new, unexpected and useful function, as established by In re Levin, 84 USPQ 232.

The Examiner rejected Claims 12-15 and 17-22 are also rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over No-Crust Sweet Potato Pie. The Examiner states "The article discloses applicant's claimed composition and a pie plate, **which is often** aluminum. Also, see the last four sentences in paragraph no. 5 above." The Office Action, page 4, paragraph 6, lines 2-4. Applicant respectfully traverses the Examiner's rejection of Claims 12-15 and 17-22 under 35 U.S.C. §103(a) using the same reasoning as used to overcome the Examiner's rejection of Claims 12-22 over each of the following articles cited by applicant: Mai Mai

Sweet Potato Pie, Sweet Potato Pie No. 2750, Mai Mai Sweet Potato Pie No. 2298, Sweet Potato Pie by Ceideburg or Sweet Potato Pie (From My Garden), *supra*. The No-Crust Sweet Potato Pie article does not teach or suggest each and every feature of Applicant's Claims 12-15 and 17-22. Specifically, the No-Crust Sweet Potato Pie article does not teach or suggest, *inter alia*, "an edible sweet potato composition, **having a smooth texture, said smooth texture being based on a mouthfeel in a range from about 5.1 to about 9.0, based on a mouthfeel test, wherein the test has a range from 1-9, wherein a 1 means dislike extremely and a 9 means like extremely**; and a receptacle," (emphasis added) as in Applicant's Claim 12. The Examiner's argument that "The article discloses applicant's claimed composition and a pie plate, **which is often** aluminum" ignores that the edible composition of Claim 12 has **"a smooth texture, said smooth texture being based on a mouthfeel in a range from about 5.1 to about 9.0, based on a mouthfeel test, wherein the test has a range from 1-9, wherein a 1 means dislike extremely and a 9 means like extremely."** The Examiner's argument also ignores that the receptacle of Claims 15, and 17 is edible, and of Claims 15 and 17-20 is not a 9" pie plate, in contrast to the Examiner's cited prior art.

Lastly, Applicant submits that nowhere does the Examiner support his conclusion that a "pie plate is often aluminum." The Office action, page 4, paragraph 6, lines 2-3. The Examiner's rejection of Claims 12-15 and 17-22 fails because the argument is conclusory. The argument that "a pie plate is often aluminum" is conclusory is because it lacks some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (In reversing the

Board's decision, the court stated "'common knowledge and common sense' on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency's obligation....The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies."). Therefore, the Examiner should withdraw his rejection of Claims 12-15 and 17-22 because the Examiner's argument that "a pie plate is often aluminum" is conclusory.

In light of the foregoing, Applicant respectfully submits that the Examiner's rejection of Claims 12-22 under 35 U.S.C. §103(a) as being allegedly unpatentable over either each of the following articles cited by applicant: Mai Mai Sweet Potato Pie, Sweet Potato Pie No. 2750, Mai Mai Sweet Potato Pie No. 2298, Sweet Potato Pie by Ceideburg or Sweet Potato Pie (From My Garden) No-Crust Sweet Potato Pie because none of the Examiner's cited prior art teaches or suggests each and every feature of Applicant's Claims 12-22. Specifically, none of the Examiner's cited prior art teaches or suggests, *inter alia*, "an edible sweet potato composition, **having a smooth texture, said smooth texture being based on a mouthfeel in a range from about 5.1 to about 9.0, based on a mouthfeel test, wherein the test has a range from 1-9, wherein a 1 means dislike extremely and a 9 means like extremely**; and a receptacle," (emphasis added) as in Applicant's Claim 12. Therefore, the Examiner has not met his burden for making a prima facie case of obviousness, so the Examiner should withdraw his rejection of claims 12-22.

CONCLUSION

Accordingly, based on the preceding arguments, Applicant respectfully submits that claims 12-22, and the entire application, are in condition for allowance and therefore requests favorable action. However, should the Examiner believe anything further is necessary in order to place the application in better condition for allowance, or if the Examiner believes that a telephone interview would be advantageous to resolve the issues presented, the Examiner is invited to contact the Applicant's undersigned representative at the telephone number listed below.

The Director is hereby authorized to charge and/or credit Deposit Account No. 50-3981.

Respectfully submitted:

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